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09/858,174	05/15/2001	Martyn Ian Butterworth	13344-9025-00	1570
23409 7590 02/19/2010 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202				
EXAMINER				
JANVIER, JEAN D				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/858,174

**Applicant(s)**

BUTTERWORTH, MARTYN IAN

**Examiner**

JEAN JANVIER

**Art Unit**

3688

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/09/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-8 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8 and 18-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Statement(s) (PTO/SF/42)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

***Response to Applicant's Arguments***

Although independent claims 1 and 18 recite “if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text”, however, the Examiner notes that it can be assumed that the recipient does answer during a predetermined time period and thus, there is no need to replace the supplementary image by connection message text. Further, the claims recite “and if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated”. Here, it can be assumed that the transmission and/or display of the supplementary image to the caller is completed during the “ring-back” or before a connection is established between the caller and the recipient. As noted above, the “if-then” claim limitation only addresses one side of the equation. In other words, the prior art has to disclose only one side of the equation, but not necessarily what is featured in the “if-then” claim limitation.

Further, contrary to the Applicant's contention, it can be concluded from Gregorek that **since the supplementary image or advertisement represents the ring-back signal per se, the transmission or the playing of the supplementary image via the caller's telecommunication apparatus ceases when the called party or recipient answers or picks up the phone (recipient's telecommunication apparatus) at the other end. That is how a conventional phone call functions.**

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the

Applicant's arguments as herein presented are not convincing and thus, the current **Office Action has been made Final.**

*Claim Status*

Claims 1, 4-8 and 18-25 are pending in the Application, while claims 2-3, 9-17 and 26-34 have been canceled.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-8, 18 and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gregorek, USP 5,428,670.

As per claims 1, 4-8, 18 and 21-25, Gregorek discloses a marketing system for selectively modifying an existing communication network (such as a telecommunication network) by modifying a portion of a processing software, which permits replacing at least a portion of a call progress signal generated by the communication network by a generally continuous pre-recorded announcement, such as advertisements (in text and/or audio/video format). A first station (telecommunication apparatus) is provided for placing a call, by a calling party or caller, at a first network address to send an (audio) message to a called party or recipient. The (telecommunication) network is adapted for connecting the call, from the caller, to an identified

called station of the recipient at a second network address (establishing a connection with the telecommunication apparatus or called station of the recipient), the called station of the recipient (telecommunication apparatus) having either a busy status (unavailable) or an idle status (available). The network is configured to initially determine the busy/idle status of the called station and if the called station has an initial busy status, then the network or system checks the busy/idle status of the called station at predetermined intervals for an idle status. A player plays/displays at least one generally continuous announcement (or supplementary image or advertisement) to the calling party for a predetermined period of time during a time period when a call progress signal (conventional audio/visual) would have been provided to the calling party after the call was placed (playing/displaying a supplementary image or announcement or advertisement after the caller places a call to a called recipient and the recipient's station is in idle status, wherein the announcement replaces a conventional ring-back signal or audio/visual message played at the caller's station and terminating the supplementary message when the recipient answers or picks up the phone). **Since the supplementary image or advertisement represents the ring-back signal, the transmission or the playing of the supplementary image via the caller's telecommunication apparatus ceases when the called party or recipient answers or picks up the phone at the other end.** The player (system) determines the announcement (supplementary image) to be played (displayed) based upon criteria established exclusively by the marketing system (e.g. advertiser) and independently of the identity of the called station. The playing of the announcement (supplementary image) is **terminated** and the call is completed to the calling station, in the case of the calling station having an initial idle status, when the called station or the telecommunication apparatus of the call recipient responds

by answering the (incoming) call from the caller or calling party (terminating the playing/displaying of the announcement or supplementary image when the called station answers the incoming call after the connection has been established). It is herein understood that both the caller's station and the recipient's station are configured to receive and transmit audio/visual (mixed media audio/video) information or messages. (See abstract; col. 1: 12-20; col. 1: 53 to col. 2: 54; col. 3: 11-50; col. 7: 1-10; col. 7: 54-59; col. 9: 14-22; figs. 1 and 3-8).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-8, 18 and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Partridge, (SIR) H1714.

As per claims 1, 4-8, 18 and 21-25, Partridge describes a system and method for selecting and transmitting a still image (supplementary image) in a telephone network. A series of images is stored in at least one storage unit coupled to the network, each image associated with a particular customer in the network. Upon the placement of a call by a caller's telecommunication apparatus, the system will automatically select and transmit the calling party's image to the called party's video telephone or terminal (or recipient's telecommunication apparatus) prior to or during the ringing sequence, or after the called party has answered (See abstract).

Further, one of the advantages of the present system is the ability of the system to alert the called party to the (supplementary) image of the calling party (caller) very early in the calling sequence. The image could be displayed at the calling party's terminal even before the first ring is sounded at the calling party's terminal **(displaying the supplementary image on the telecommunication apparatus of the caller even before the first ring is sounded at the caller's terminal)**. Alternatively, the image could appear on the screen simultaneously with the first ring or with some subsequent ring, at some predetermined interval after the ringing has begun, or after the called party has answered **(establishing a connection between a caller's terminal and a recipient's terminal, displaying the supplementary image on the telecommunication apparatus or terminal of the caller thereafter or even before or after the first ring is sounded at the caller's terminal after a predetermined period of time, simultaneously with the first ring of after the called party answers)**. This allows the called party to screen the call depending upon the particular image, which advantageously permits the called party to dispense with the need to memorize the telephone numbers of calling individuals. In addition, by starting image transmission prior to or during ringing, it is likely that, by the time the called party has answered the call, enough time will have elapsed to permit the system to transmit and reconstruct a relatively high-resolution image at the called terminal, even if network bandwidth is limited (col. 6: 27-45).

See abstract; figs. 1 and 2; col. 1: 36-67; col. 3: 66 to col. 4: 8; col. 5: 55-57; col. 2: 39-67; cl. 5: 65 to col. 6: 15; col. 6: 27-45; col. 3: 33-41; col. 4: 46-53; col. 3: 33-41.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek, USP 5,428, 670 in view of Gabbard, USP 6,205,432.**

As per claims 19-20, Gregorek does not disclose that the caller inserts a supplementary image (ad) into the message sent to the recipient, and if the message is a text messaging, then the supplementary image is inserted in part of the message from the caller and will be visible to the recipient on retrieval (receipt) of the (text) message.

However, Gabbard discloses an advertisement system and method for inserting into an end-user's communication message or e-mail a background reference to an advertisement. The background reference causes an advertisement image to be tiled or watermarked across an end-user screen behind the text of an e-mail message (or public posting) that will be sent from the user or sender to another user or recipient. A message server inserts the background reference (ad) after receiving a message or an e-mail (text message) originally sent from an end-user originator (sender) and before sending the message to be delivered to an end-user recipient (recipient). When necessary, the message server will convert at least a portion of the message into a proper format, such as HTML, before inserting the background reference to an



advertisement, which is preferably selected in accordance with end user recipient demographic information and/or ad exposure statistics. The advertisement itself, often a graphical file, is preferably not transmitted with the message, but is typically stored at the message server or other location remote from the end-user recipient. Preferably, the message server maintains and refers to records on each end-user recipient to allow for selective enablement of background reference insertion and overwriting based upon end user preferences. According to various "non-web" example embodiments, the message server transmits an SMTP, POP3 or NNTP message with an HTML portion for a respective HTML-compatible client. In other "web-based" example embodiments, the message server transmits the entire message in HTML to be used as a stand-alone web page or as a portion of a larger page employing frames or tables (see abstract).

Therefore, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the teachings of Gabbard into the system of Gregorek so as to send by a sender/caller a message, text message or e-mail message to a recipient, via a communication network or telecommunication system, wherein a server is configured to insert a targeted advertisement (supplementary image) into the text message or e-mail message before the text message or e-mail message is delivered or played/displayed to the caller or recipient, thereby taking advantage of a text message or e-mail message sent, by a sender/caller, to a recipient to present to the recipient a targeted ad (supplementary image), based on the recipient's profile, inserted into the e-mail message before it is delivered to the recipient, while enabling the owner of the communication or telecommunication system to raise important funds or revenue by charging the advertiser, associated with the inserted targeted advertisement, a fee for presenting

or displaying/playing his advertisement to the recipient of the sender's/caller's text message or e-mail.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**USP Re. 34,380 to Sleevi** discloses a telecommunication network, a system for applying messages or data to the customer lines of calling parties or callers during the (conventional) "ringback" period of telephone call set up. The messages are preferably applied between successive ringback tones during the ringback period and are terminated when the called party or recipient answers the (incoming) call from the caller (terminating the supplementary images when a connection is established between the caller's device and the recipient's device or the recipient answers the call). Advertising messages, civic or company announcements, political messages, informational messages (e.g. news or weather), or other data can be transmitted on the telephone lines during what is otherwise essentially unused times when the line is already tied up (See abstract).

USP 5,652, 784 to Blen discloses a telephone advertising service for providing a short advertising message through a telephone receiver as a telephone call is initiated. The advertising message is stopped after a predetermined run time, and an invitation-to-dial tone is added. The advertising message is stopped when a subscriber starts to dial numbers. The method provides the advertising messages in lieu of invitation-to-dial tones. Differentiated subscribers are individually provided with distinct advertising messages. Subscribers are distinguished by characteristics of exchange number, monthly call volume, call type, geographical location and

time of day. The advertising messages are provided by a message system rack connected to a digital or analog telephone exchange. Each rack has plural message recorders and plural cards connected to multiple users. Software controls a connection network. Subscriber lines are sampled to sense when a call is being initiated and to signal to a controller that a telephone call is being initiated. A PCM audio interface is activated. An available message channel is switched to the subscriber line, and a corresponding message is played over the subscriber line. Soon the subscriber line is connected to the telephone exchange, and an invitation-to-dial tone is provided. Several different messages are offered in different sets of channels, changing the messages depending on the time of day. When a prohibit service signal is active, the subscriber line is switched directly to the telephone exchange (See abstract).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally

be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Ms. Lynda Jasmin, can be reached at (571)272- 6782.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

02/15/10

/J. J./

/Jean Janvier/

Primary Examiner, Art Unit 3688